

### REMARKS

This is a full and timely response to the non-final Official Action dated **February 19, 2010** (the “Office Action” or “Action”). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

#### Claim Status:

By the preceding amendment, the claims have been renumbered to eliminate the incorrect numbering of the previous preliminary amendment. Specifically, the new claims presented in the preliminary amendment of December 16, 2005 as claims 16-29 have been renumbered as claims 17-30.

Claims 1-16 were previously cancelled without prejudice or disclaimer. By the preceding amendment, claims 17-30 have been amended. No claims have been added or cancelled. Thus, claims 17-30 are currently pending for further action.

#### Objection to Specification:

In the outstanding Office Action, the Examiner objected to the specification as failing to provide a proper antecedent basis for the claimed subject matter. (Action, p. 2) (citing to 37 C.F.R. § 1.75(d)(1); M.P.E.P. §§ 608.01(o), 2181). For at least the following reasons, this objection is improper and should be withdrawn.

The Action first asserts that the specification fails to provide proper antecedent basis for various “means for . . .” clauses in claims 22, 23, and 25 (formerly claims 21, 22, and 24).

(Action, p. 2). While Applicant expressly disagrees with the Examiner in this regard, this objection is rendered moot by the preceding amendment and should therefore be withdrawn.

The Action further asserts that the specification fails to provide adequate antecedent basis for the “business service entity information element” recited in claim 26 (formerly claim 25).

(Action, p. 2). Applicant respectfully disagrees. The specification expressly states that “each businessEntity information contain[s] one or more *businessService information elements*.”

(Applicant’s Specification, p. 4 lines 20-22) (emphasis added). The specification further teaches that each businessService information element contains “one or more binding template information elements and each binding template contain[s] one or more references each referring to a technical model information element.” (*Id.*, lines 21-24; *see also id.*, p. 8 lines 26-36).

Thus, the specification plainly provides antecedent basis for the “business entity information element” recited in claim 26.

The Action additionally asserts that the specification fails to provide an adequate antecedent basis for the term “binding template information element” recited in claim 26 (formerly claim 25). (Action, p. 3). Applicant again strongly disagrees. Again, the specification expressly states that each “businessService contain[s] one or more *binding template information elements* and each binding template contain[s] one or more references to a technical model information element.” (Applicant’s Specification, p. 4 lines 21-24).

In light of the above considerations, the Action’s position that the specification fails to provide sufficient antecedent basis for claim 26 is without basis and improper. As such, the objection to the specification on these grounds should be withdrawn.

Claim Objections:

The Action objects to claim 17 (formerly claim 16) because of a typographical informality. (Action, p. 3). This informality has been corrected by the present amendment to claim 17.

The Action further objects to claim 17 because of a numbering discrepancy between Applicant's preliminary amendment of December 16, 2005 and the numbering of the original claims filed with the application. (Action, p. 3). This problem has been corrected by the preceding amendment in which claims 16-29 of the preliminary amendment have been renumbered as claims 17-30.

The Action also objects to claim 27 (formerly claim 26) because of the use of the word "therewith." (Action, p. 3). While Applicant does not necessarily agree with the Examiner's interpretation of the word "therewith" in this particular context, in the interest of cooperation the word "therewith" has been replaced by "thereon," as suggested by the Examiner, in the preceding amendment to claim 27.

For at least the above reasons, the preceding amendment has rendered all of the claim objections in the Action moot. Accordingly, withdrawal of these objections is in order.

35 U.S.C. § 112, first paragraph:

Claims 22-26 (formerly claims 21-25) were rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. According to the Examiner, each of the claims contains subject matter which was not described in the specification. Applicant respectfully disagrees.

The Action first asserts that the specification fails to disclose the existence of various “means for . . .” clauses in claims 22, 23, and 25. (Action, p. 4). Applicant strongly disagrees. Nevertheless, this assertion are rendered moot by the preceding amendment to claims 22, 23, and 25.

The Action further asserts that the specification fails to disclose the existence of the “business service entity information element” recited in claim 26 (formerly claim 25). (Action, p. 4). Applicant strongly disagrees. The specification expressly states that “each businessEntity information contain[s] one or more *businessService information elements*.” (Applicant’s Specification, p. 4 lines 20-22) (emphasis added). The specification further teaches that each business Service information element contains “one or more binding template information elements and each binding template contain[s] one or more references each referring to a technical model information element.” (*Id.*, lines 21-24; *see also id.*, p. 8 lines 26-36). Thus, the specification plainly provides antecedent basis for the “business entity information element” recited in claim 26.

The Action additionally asserts that the specification fails to disclose the existence of the “binding template information element” recited in claim 26 (formerly claim 25). (Action, p. 3). Applicant again strongly disagrees. Again, the specification expressly states that each “businessService contain[s] one or more *binding template information elements* and each binding template contain[s] one or more references to a technical model information element.” (Applicant’s Specification, p. 4 lines 21-24).

For at least the above reasons, the Examiner has not established that any of the elements recited in claims 22-26 is without written description in the specification. Consequently, this rejection should be reconsidered and withdrawn.

35 U.S.C. § 112, second paragraph:

1. Claims 21-26 (formerly claims 20-25) were rejected under 35 U.S.C. § 112, second paragraph. In making this rejection, the Examiner asserts that every “means for . . .” clause recited in claims 21-26 is indefinite under § 112, second paragraph. Applicant strongly disagrees. Nevertheless, this assertion is rendered moot by the preceding amendments to claims 22-27.
2. Claims 17-30 (formerly claims 16-29) were rejected as being indefinite under 35 U.S.C. § 112, second paragraph because the Examiner has not found a lexicographic definition for the phrase “business entity definition” and it is the Examiner’s position that this phrase is “not known to those of ordinary skill in the art.” (Action, p. 13). This rejection is utterly improper and inappropriate, as the Examiner has not set forth adequate grounds of rejecting these claims.

The M.P.E.P. is quite clear that “a claim term that is not used *or defined* in the specification is not indefinite if the meaning of the claim term is discernible.” M.P.E.P. § 2173.02 (citing to *Bancorp Sves., L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372, 69 USPQ2d 1996, 1999-2000 (Fed. Cir. 2004)). The Examiner’s requirement that each claim term be either specifically defined in the specification or well-known in the art precludes the notion that a claim’s term can be discernible from how it is used in the specification in spite of the lack

of a formal definition. *See id.*; *Markman v. Westview Instruments*, 116 U.S. 1384, 38 USPQ2d 1461 (1996) (the meaning of words used in the claims is determined by the meaning given to those words in the specification); *McGill, Inc. v. John Zink Co.*, 736 F.2d 666, 674 (Fed. Cir. 1984); *ZMI Corp. v. Cardiac Resuscitator Corp.*, 884 F.2d 1576, 1580, 6 USPQ2d 1557, 1560-61 (Fed. Cir. 1988).

In determining whether a claim term is indefinite under § 112, second paragraph, the M.P.E.P. requires an examination of the “content of the particular application disclosure,” but no requirement is made that an explicit definition be made of the term within the disclosure. M.P.E.P. § 2173.02. If the specification makes the meaning of a claimed term clear, that term is plainly not indefinite under 35 U.S.C. § 112, second paragraph.

The term “business entity definition” is used throughout Applicant’s specification as an entity in a registry, such as a Universal Description Discovery and Integration (UDDI) registry, through which a business entity publishes information about the services it provides in the form of definitions, each definition including one or more information elements. (*See, e.g.*, Applicant’s Specification, title, p. 2 lines 1-4, p. 3 lines 5-9, p. 4 lines 18-24). Moreover, Applicant notes that such business entity definitions are well-known in the art in the context of UDDI registries. *See, e.g.*, UDDI Version 3.0.2 Specification, [http://www.uddi.org/pubs/uddi\\_v3.htm](http://www.uddi.org/pubs/uddi_v3.htm) (“the focus of [UDDI] . . . is the definition of a set of services supporting the description and discovery of 1) businesses, organizations, and other Web services providers, 2) the Web services they make available, and 3) the technical interfaces which may be used to access those services”).

Thus, the meaning of the term “business entity definition” is not indefinite under 35 U.S.C. § 112, second paragraph, because this term sets out and circumscribes a particular subject matter with a reasonable degree of clarity and particularity” in light of the “content of the particular application disclosure,” the “teachings of the prior art,” and “the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.” M.P.E.P. § 2173.01.

Again, the rejection of claims 17-30 based on 35 U.S.C. § 112, second paragraph is wholly inappropriate and falls outside the authority of the Examiner. Therefore, this rejection should be reconsidered and withdrawn.

3. Claim 26 (formerly claim 25) was further rejected under 35 U.S.C. § 112, second paragraph because of the Examiner’s position that the terms “business service entity information element,” “binding template information element,” and “technical model information element,” and “business entity information element” are indefinite. Applicant strongly disagrees.

Again, the Examiner is inappropriately requiring that these terms be either specifically defined in the specification or well-known in the art to comply with § 112, second paragraph. This standard has no legal basis. Again, the “essential inquiry” pertaining to compliance with 35 U.S.C. § 112, second paragraph is “whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity” in light of the “(A) [t]he content of the particular application disclosure; (B) [t]he teachings of the prior art; and (C) [t]he claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.” M.P.E.P. § 2173.01. No explicit definition of

these terms is required for “content of the particular application disclosure” to provide a basis for whether the claimed subject matter has “a reasonable degree of clarity and particularity.” *Id.*; *see also Bancorp*, 359 F.3d at 1372, 69 USPQ2d 1999-2000 (a claim term this is not defined in the specification is not indefinite if the meaning of the claim term is discernible).

The Examiner has failed to comprehend that claim 25 is directed to a UDDI registry, and the terms recited in claim 25 reflect concepts that are well-known in the field of UDDI. *See, e.g.*, UDDI Version 3.0.2 Specification, [http://www.uddi.org/pubs/uddi\\_v3.htm](http://www.uddi.org/pubs/uddi_v3.htm). The UDDI standard provides clear evidence that these concepts are well-known in the art. Furthermore, Applicant’s specification describes these terms in context, from which one having ordinary skill in the art could easily determine the metes and bounds of the subject matter claimed. (Applicant’s Specification, para. 0003, 0013, 0015, 0026-

As such, the Examiner has rejected claim 26 while clearly failing to perform the necessary inquiry into whether the terms “whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity” in light of the “(A) [t]he content of the particular application disclosure; (B) [t]he teachings of the prior art; and (C) [t]he claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.” M.P.E.P. § 2173.01.

The Examiner has failed to meet the requisite burden of demonstrating the *prima facie* unpatentability of claim 26 under 35 U.S.C. § 112, second paragraph. Consequently, the rejection of claim 26 based on 35 U.S.C. § 112, second paragraph should be reconsidered and withdrawn.

35 U.S.C. § 101:

1. Claims 17-20 (formerly claims 16-19) were rejected under 35 U.S.C. § 101 as being directed to non-statutory methods in light of the machine-or-transformation test set forth in *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008) (*en banc*) (cert granted).

In particular, the Action asserts that the steps recited in claim 17 are not tied to a specific machine and do not transform the underlying subject matter to a different state or thing. While Applicant expressly does not agree with the Examiner's assessment in this regard, claim 17 has been amended to more specifically recite that each step is performed by a "processor associated with said registry." (Claim 17). Support for the amendment to claim 17 can be found in Applicant's original specification at, for example, page 5 lines 21-31 and page 12 lines 24-33.

Accordingly, each step recited in claims 17-20 is now positively tied to a special purpose machine configured to perform that step. *See In re Allapat*, 33 F.3d 1526, 1545 (Fed. Cir. 1994) (*en banc*). Thus, claims 17-20 are clearly directed to statutory subject matter under 35 U.S.C. § 101 because "[a] claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing." *Bilski*, 545 F.3d at 954. Consequently, the rejection of claims 17-20 based on 35 U.S.C. § 101 should be reconsidered and withdrawn.

2. Claims 21-26 (formerly claims 20-25) were rejected under 35 U.S.C. § 101 as not being directed to a particular machine or transformation of matter. While Applicant expressly disagrees with the Examiner's assertions that the means-plus-function limitations previously

recited in claim 21 were not tied to a particular structure, these assertions are moot in light of the preceding amendment to claim 21.

Applicant further notes that claim 21 now recites “at least one processor” and “a computer readable memory communicatively coupled to said processor” where the processor is configured to perform the functionality recited in claim 21. Support for the amendment to claim 21 can also be found in Applicant’s original specification at, for example, page 5 lines 21-31 and page 12 lines 24-33.

Claim 21 is now expressly tied to a specific machine—a processor that performs the special functionality of managing a registry of business entity definitions and a memory that stores the business entity definitions. Thus, claims 21-26 are clearly directed to statutory subject matter under 35 U.S.C. § 101 because “[a] claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” *Bilski*, 545 F.3d at 954. Consequently, the rejection of claims 21-26 based on 35 U.S.C. § 101 should be reconsidered and withdrawn.

Prior Art:

1. Claims 17, 21, and 27 (formerly claims 16, 20, and 26) were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,414,852 to Kramer (“Kramer”). For at least the following reasons, this rejection should be reconsidered and withdrawn.

Claim 17:

Claim 17 recites:

A method for a registry of business entity definitions to handle user requests to access business entity definitions, the method comprising:  
 receiving a request in a processor associated with said registry from a user to access ***a business entity definition comprising a plurality of information elements, each of said information elements having permission details associated therewith;***  
 obtaining the identity of the user from data associated with the request with said processor;  
 determining with said processor, ***for each of said information elements, whether the user has permission to access that said information element based on the permission details associated with that said information element and said identity of the user;*** and  
 with said processor, ***denying the user access to those information elements for which it is determined that the user does not have permission.***

(Emphasis added).

Applicant notes that “[t]he examiner bears the initial burden . . . of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In a rejection made under § 102, this burden is substantial, as a *prima facie* case of anticipation requires a demonstration that “*each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added); *see* M.P.E.P. § 2131.

The Federal Circuit has further clarified that “unless a reference discloses within the four corners of the document *not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim*, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.” *Net*

*MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1371, 88 U.S.P.Q.2d 1751, 1759 (Fed. Cir. 2008) (emphasis added).

In light of these considerations, the recent Office Action does not meet the requisite burden to establish the *prima facie* anticipation of claim 17. Specifically, the Examiner has failed to demonstrate that the Kramer reference teaches or suggests *each and every element* recited in claim 17. *See Verdegaal*, 814 F.2d at 631, 2 USPQ2d at 1053.

Kramer is directed to “a data processing system [that] includes a plurality of data objects which are accessible by application programs through a system level interface.” (Kramer, col. 1 lines 56-59). According to Kramer, “[e]ach data object has an associated user access list” and “at least one key indicating which applications can access that object.” (*Id.*, lines 59-62). “Both the application identifier key and the user who invoked that application must match the identifier information in the data object for access to be allowed to that object.” (*Id.*, lines 64-67).

The Action cites to teachings in Kramer about a user attempting to access such a data object, asserting that the data object of Kramer reads on the “business entity definition” recited in claim 17. Applicant respectfully disagrees. In construing a claim, the meaning of words used in the claims is determined by the meaning given to those words in the specification. *Markman v. Westview Instruments*, 116 U.S. 1384, 38 USPQ2d 1461 (1996); *McGill, Inc. v. John Zink Co.*, 736 F.2d 666, 674 (Fed. Cir. 1984); *ZMI Corp. v. Cardiac Resuscitator Corp.*, 884 F.2d 1576, 1580, 6 USPQ2d 1557, 1560-61 (Fed. Cir. 1988) (“words must be used in the same way in both the claims and the specification”).

The specification uses the term “business entity definition” to refer an organization of data that “provides details of services provided . . . by a business” and “descriptive information . .

. of the business.” (Applicant’s Specification, p. 5 line 40 to p. 6 line 9). Thus, from the plain language of the term “business entity definition” and the fact that the specification only uses this term to refer to an organization of data corresponding to a specific data, to anticipate the term “business entity definition” the data object of Kramer must be associated with a business entity. Kramer does not teach or suggest anywhere that each of its data objects is associated with a business entity. Accordingly, the data object of Kramer does not read on the “business entity definition” recited in claim 17, and Kramer does not teach or suggest “receiving a request from a user to access a business entity definition.” (Claim 17).

The Action cites to Kramer’s teaching that an “object header” of a data object includes “two types of information . . . relevant to access control,” as evidence that Kramer teaches the plurality of information elements recited in claim 17. (Action, p. 20) (citing to Kramer, col. 3 line 60 to col. 4 line 10). Kramer is indisputably clear in the cited portions that these two types of information are an access control list and a key list. (Kramer, col. 3 line 60 to col. 4 line 70).

However, by asserting that the access control list and key list in Kramer read on the “information elements having permission details associated therewith” recited in claim 17, the Action puts itself in a logically untenable position. This untenable position stems from the fact that claim 17 recites “determining . . . for each of said information elements, whether the user has permission to access that said information element based on the permission details associated with that said information element.”

Thus, by asserting that the access control list and key list in Kramer read on the information elements recited in claim 17, in order for Kramer to teach determining whether the user has permission to access each information element based on the permission details

associated therewith, Kramer must teach a) determining from the permissions in the access list whether the user can access the access list itself, and b) determining from the permissions in the key list whether *the user* can access *the key list itself*.

However, Kramer does not teach determining from the permissions in the key list whether the user can access the key list. In fact, Kramer is very clear that the key list only includes a list of software applications (“data managers”) that are allowed to access the data of the data object. (Kramer, col. 2 line 65 to col. 3 line 7, col. 4 lines 11-22). Thus, the permissions in the key list pertain only to specific applications and not to any particular user. Thus, Kramer *cannot* teach using the key list to determine whether a *user* has access to the key list.

Moreover, Kramer fails to teach or suggest that the permissions data in the key list grants access to the key list itself. Rather, Kramer teaches that “the key list . . . is accessible only by the system level interface 20” which evaluates requests for access, and that the “key list is stored in . . . a protected storage area.” (*Id.*, col. 4 lines 40-47).

Finally, Kramer does not teach or suggest “denying the user access to those information elements for which it is determined that the user does not have permission.” (Claim 17). Again, claim 17 is explicit that a business entity definition includes multiple information elements and that a user is denied access on an individual basis to those information elements for which the user does not have permission. In this regard, the Action asserts that “each ‘information element’ can be contained in a separate object” which “results in a per ‘information element’ control being exhibited.” (Action, pp. 20-21). The Examiner’s position in this regard contradicts itself. At first, the Examiner asserted that the “data objects” of Kramer have multiple information elements within a single object, and here the Examiner asserts that the information elements are all within

separate data objects. The Examiner cannot have it both ways, especially because Kramer provides no support for this position. Even if the Examiner's double view of Kramer were logically sound, the denial of access to separate data objects, each object holding its own information element, plainly does not anticipate the denial of access to information elements on an individual basis where "a plurality of information elements" is in a single business entity definition. (Claim 17).

Again, "[a] claim is anticipated [under 35 U.S.C. § 102] only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal*, 814 F.2d at 631, 2 U.S.P.Q.2d at 1053; *see Verisign*, 545 F.3d at 1371, 88 U.S.P.Q.2d at 1759; M.P.E.P. § 2131. Thus, Kramer cannot anticipate claim 17 because, for the above reasons, Kramer fails to teach or suggest all of the subject matter present in claim 17. Because the Office has not met its burden to demonstrate the *prima facie* unpatentability of claim 17, the rejection of claim 17 and its dependent claims based on Kramer should be reconsidered and withdrawn.

Claim 21:

Claim 21 recites:

A registry of business entity definitions, the registry comprising:  
at least one processor; and  
a computer readable memory communicatively coupled to said processor having said business entity definitions stored thereon;  
wherein said processor is configured to:  
*receive a request from a user to access a business entity definition comprising a plurality of information elements, each of said information elements having permission details associated therewith;*  
obtain the identity of the user from data associated with the request;

*determine, for each of said information elements, whether the user has permission to access that said information element based on the permission details associated with that said information element and said identity of the user; and deny the user access to those information elements for which it is determined that the user does not have permission.*  
(Emphasis added).

Kramer also fails to anticipate the registry of business entity definitions of claim 21 because Kramer does not teach or suggest all of the subject matter recited in claim 21. Specifically, as amply demonstrated above with respect to independent claim 17, Kramer does not teach or suggest “receiv[ing] a request from a user to access a business entity definition comprising a plurality of information elements, each of said information elements having permission details associated therewith,” “determin[ing], for each of said information elements, whether the user has permission to access that said information element based on the permission details associated with that said information element and said identity of the user;” or “deny[ing] the user access to those information elements for which it is determined that the user does not have permission.” (Claim 21).

Again, “[a] claim is anticipated [under 35 U.S.C. § 102] only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal*, 814 F.2d at 631, 2 U.S.P.Q.2d at 1053; *see Verisign*, 545 F.3d at 1371, 88 U.S.P.Q.2d at 1759; M.P.E.P. § 2131. Thus, Kramer cannot anticipate claim 21 because, for the above reasons, Kramer fails to teach or suggest all of the subject matter present in claim 21. Because the Office has not met its burden to demonstrate the *prima facie* unpatentability of claim 21, the rejection of claim 21 and its dependent claims based on Kramer should be reconsidered and withdrawn.

Claim 27:

Claim 27 recites:

A computer program product for a registry of business entity definitions to handle user requests to access business entity definitions, the computer program product comprising:

a computer readable storage medium having computer usable program code embodied thereon, the computer usable program code comprising:

computer usable program code configured to *receive a request from a user to access a business entity definition comprising a plurality of information elements, each of said information elements having permission details associated therewith;*

computer usable program code configured to obtain the identity of the user from data associated with the request;

computer usable program code configured to *determine, for each of said information elements, whether the user has permission to access that said information element based on the permission details associated with that said information element and said identity of the user;* and

computer usable program code configured to *deny the user access to those information elements for which it is determined that the user does not have permission.*

(Emphasis added).

Kramer also fails to anticipate the computer program product of claim 27 because Kramer does not teach or suggest all of the subject matter recited in claim 27. Specifically, as amply demonstrated above with respect to independent claim 17, Kramer does not teach or suggest “receiv[ing] a request from a user to access a business entity definition comprising a plurality of information elements, each of said information elements having permission details associated therewith,” “determin[ing], for each of said information elements, whether the user has permission to access that said information element based on the permission details associated with that said information element and said identity of the user;” or “deny[ing] the user access to those information elements for which it is determined that the user does not have permission.” (Claim 27).

Again, “[a] claim is anticipated [under 35 U.S.C. § 102] only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal*, 814 F.2d at 631, 2 U.S.P.Q.2d at 1053; *see Verisign*, 545 F.3d at 1371, 88 U.S.P.Q.2d at 1759; M.P.E.P. § 2131. Thus, Kramer cannot anticipate claim 27 because, for the above reasons, Kramer fails to teach or suggest all of the subject matter present in claim 27. Because the Office has not met its burden to demonstrate the *prima facie* unpatentability of claim 27, the rejection of claim 27 and its dependent claims based on Kramer should be reconsidered and withdrawn.

2. Claims 19, 20, 23, 24, 29, and 30 (formerly claims 18, 19, 22, 23, 28, and 29) were rejected under 35 U.S.C. § 103(a) as being obvious over Kramer in view of U.S. Patent No. 5,692,980 to Stefik (“Stefik”). This rejection is respectfully traversed and should be reconsidered and withdrawn at least for the same reasons given above in favor of the patentability of claims independent claims 17, 21, and 27. *See In re Fine*, 837 F.2d 1071, 1076, 5 USPQ2d 1596 (Fed. Cir. 1988) (if an independent claim is nonobvious, then any claim depending therefrom is nonobvious); M.P.E.P. § 2143.03.

3. Claims 18, 22, 25, 26, and 28 (formerly claims 17, 21, 24, 25, and 27) were rejected under 35 U.S.C. § 103(a) as being obvious over Kramer in view of U.S. Patent Application Publication No. 2002/0046157 by Solomon (“Solomon”). This rejection is respectfully traversed and should be reconsidered and withdrawn at least for the same reasons given above in favor of the patentability of claims independent claims 17, 21, and 27. *See Fine*, 837 F.2d at

1076 (if an independent claim is nonobvious, then any claim depending therefrom is nonobvious); M.P.E.P. § 2143.03.

4. Claims 17, 21, and 27 (formerly claims 16, 20, and 26) were alternately rejected under 35 U.S.C. § 103(a) as being obvious over Kramer in view of Stefik.

In rejecting claims 17, 21, and 27 under these alternate grounds, the Examiner maintains the assertion that Kramer teaches “receiving a request . . . from a user to access a business entity definition comprising a plurality of information elements, each of said information elements having permission details associated therewith” and “determining . . . for each of said information elements, whether the user has permission to access that said information element based on the permission details associated with that said information element and said identity of the user;” and “denying the user access to those information elements for which it is determined that the user does not have permission” for the same reasons used by the Examiner to reject these claims under § 102(b). (Action, pp. 24-25). Applicant strongly disagrees with these assertions for the same reasons given above with respect to the § 102(b) rejection, noting that the Examiner has utterly failed to establish that Kramer teaches or suggests any of this subject matter.

Stefik does not remedy the deficiencies of Kramer in this regard. Specifically, Stefik utterly fails to teach or suggest at least the subject matter of “receiving a request . . . from a user to access a business entity definition comprising a plurality of information elements, each of said information elements having permission details associated therewith” and “determining . . . for each of said information elements, whether the user has permission to access that said

information element based on the permission details associated with that said information element and said identity of the user.” (See claims 17, 21, and 27).

Applicant notes that the present rejection relies on an assertion of obviousness based on the combination of prior art elements according to known methods to yield predictable results. According to the M.P.E.P., “[t]o reject a claim based on this rationale, Office personnel must resolve the . . . factual inquiries” of *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966). M.P.E.P. § 2143. The Supreme Court recently reaffirmed that the *Graham* factors “continue to define the inquiry that controls” obviousness rejections under § 103. *KSR Int’l v. Teleflex Inc.*, 550 U.S. 398, 407 (2007).

Under the analysis required by *Graham*, to support a rejection under 35 U.S.C. § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. *Graham*, 383 U.S. at 17-18. While it is true that attacking references individually is not sufficient to demonstrate nonobviousness, *In re Keller*, 642 F.2d 413, 426, 208 USPQ 871 (CCPA 1981), the scope and content of the prior art as a whole may only be determined by a methodical examination of each prior art reference to determine what each reference teaches and does not teach. If such an examination reveals that *each* cited prior art reference fails to teach or suggest a particular claimed element, it follows that the scope and content of the cited prior art does not include that element.

Applying the *Graham* analysis to the present case, the scope and content of the prior art, as evidenced by Kramer and Stefik, did not include the claimed subject matter, particularly at least “receiving a request . . . from a user to access a business entity definition comprising a

plurality of information elements, each of said information elements having permission details associated therewith” and “determining . . . for each of said information elements, whether the user has permission to access that said information element based on the permission details associated with that said information element and said identity of the user.” (*See* claims 17, 21, and 27).

The differences between the cited prior art and claims 17, 21, and 27 are significant because the claimed subject matter provides features and advantages not known or available in the cited prior art. Consequently, the cited prior art will not support a rejection of claim 17, 21, and 27 under 35 U.S.C. § 103 and *Graham*. For at least these reasons, the rejection of claims 17, 21, and 27 and their independent claims based on Kramer and Selik should be reconsidered and withdrawn.

Conclusion:

In view of the preceding arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments in future papers supporting the patentability of any of the claims, including the separate patentability of the dependent claims not explicitly addressed herein. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

The absence of a reply to a specific rejection, issue or comment in the Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing

in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If the Examiner has any comments or suggestions which could place this application in better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

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/Steven L. Nichols/  
Steven L. Nichols  
Registration No. 40,326

Steven L. Nichols, Esq.  
**Van Cott, Bagley, Cornwall & McCarthy**  
36 South State Street  
Suite 1900  
Salt Lake City, Utah 84111

(801) 237-0251 (phone)  
(801) 237-0871 (fax)